

complies with 35 U.S.C. § 120, which requires that an application claiming the benefit of an earlier filing date be co-pending with the parent application.

Priority under § 120 was first raised in Paper 9, "Declaration, Power of Attorney and Petition" filed on August 11, 1997, in the prosecution of Application Serial No. 09/464,792 filed on September 19, 1996, which issued as U.S. Patent 5,863,927. The first paragraph on the second page of the paper explains the claim of priority:

We claim the benefit under Title 35, United States Code, §120, of prior United States applications 08/114,845, filed on September 2, 1993, which issued as US patent 5,366,980 on November 22, 1994, and of its copending parent application, serial number 07/896,053, filed on June 9, 1992, abandoned. In addition, we claim the benefit of an international Patent Cooperation Treaty application, serial number PCT/US94/10771, filed on September 22, 1994, which designated the United States. The current US application (Serial No. 08/464,792) is the national counterpart of that international PCT application; their texts and claims are substantially identical. The international application (filed in September 1994) was co-pending with US application 08/114,845, which issued as a US patent in November 1994.

Because the PCT application was not filed in a foreign country, the provision of 35 U.S.C. § 119 requiring filing the US application with 12 months of the earliest foreign filing does not apply to the instant case. Instead, § 120 applies, which requires only that the applications are copending.

Applicants amended the Related Applications information in conformity with the above reasoning in Paper 12 "First Response with Amendment" also filed on August 11, 1997. The amended language was essentially identical to the language in the instant amendment:

This application is a continuation-in-part of US application 08/114,845 filed September 2, 1993, which issued as U.S. Patent 5,366,980 on November 22, 1994, and which in turn was a continuation-in-part of US application 07/896,053 filed June 9, 1992, now abandoned. Applicants also claim the benefit of a Patent Cooperation Treaty application serial number PCT/US94/10771 filed September 22, 1994, which designated the United States.

The related applications information that issued in U.S. Patent 5,863,927 was inserted in Paper 18 "Supplemental Examiner's Amendment" mailed October 7, 1998. At that time, Applicants neglected to point out to the Examiner that the instant application was in fact entitled to the benefit of an earlier filing date as provided under § 120. Accordingly, Applicants are now filing this reissue application to correct this inadvertent error.

Applicants have not amended the claims or figures. U.S. Patent 5,863,927 is not modified by any disclaimer or certificate of correction. The patent is not presently nor has it in the past been the subject of any interference, reexamination, or litigation proceedings, nor any reissue proceedings other than the instant application.

CONCLUSION

In view of the amendment to the specification, Applicants respectfully submit that the present application is in condition for allowance. Should the Examiner have any concerns that might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 1/18/02

By: Mark R. Benedict
Mark R. Benedict
Registration No. 44,531
Attorney of Record
620 Newport Center Drive
Sixteenth Floor
Newport Beach, CA 92660
(949) 760-0404

H:\DOCS\PTH\AVANIR.079RX\PRELIMINARY AMENDMENT.DOC

111501